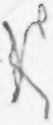

FILE COPY

Office Supreme Court U.S.
FILED
MAY 12 19
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

NO. 855

NATIONAL LATEX PRODUCTS COMPANY and THE AKRON PRESFORM MOLD COMPANY,
Petitioners,

v.

THE SUN RUBBER COMPANY, Respondent.

On Petition for Writ of Certiorari to The United States Court of Appeals for The Sixth Circuit.

REPLY BRIEF FOR PETITIONERS

WALTER J. BLENKO
1319 Farmers Bank Building
Pittsburgh 22, Pennsylvania
Attorney for Petitioners

WM. C. McCOY
WM. C. McCOY, JR.
ALBERT H. OLDHAM
FREDERICK B. ZIESENHEIM
Of Counsel

May 12, 1960.

SMITH BROS. CO. INC., LAW PRINTERS, 434-438 BLVD. OF ALLIES, PITTSBURGH 19, PA.

REPLY BRIEF FOR PETITIONERS

I. Contrary to the assertions in Respondent's Brief, the action of the Court of Appeals is in conflict with the rule of this Court in *Western Pacific Railroad Case*, 345 U.S. 247, and with decisions of other Courts of Appeals.

(a) Respondent confuses the thrust of the Petition. Petitioners agree that the rule in *Western Pacific* permits a Court of Appeals to place initial responsibility for initiating *en banc* proceedings with a properly constituted division of the court. In the instant case, however, the Court of Appeals, after stating that the court *en banc* will not consider petitions for rehearing, followed with the conclusion that "The motion that the appeals be reheard en banc * * * *must* be denied" (emphasis supplied). It thereby forecloses both rehearings *en banc* and petitions for rehearing *en banc*. That policy was reiterated in the Order of the court filed April 6, 1960 (Pet. 14-15).

Respondent seeks to justify the action of the Court of Appeals by characterizing it as part of a continuous policy long established in the Sixth Circuit (Respt's. Br. 6-8). Petitioners agree and pointed out that the lower court appears never to have reheard a case *en banc* (Pet. 13-14). Respondent does not controvert this fact but contents itself by calling petitioners' view of the policy of the Court of Appeals "unfounded" (Respt's. Br. 8). The fact that the practice in the Sixth Circuit is long standing cannot reconcile conflicts in that practice with the decision of this Court in *Western Pacific* and with decisions of other Courts of Appeals.

(b) Contrary to respondent's assertion (Respt's. Br. 9) there is a conflict among the various Courts of Appeals. We invite attention to the opinion of Judge Schnackenberg in *G. H. Miller & Company v. United States* (C. A. 7, 1958) 260 F.2d 286 at page 291 stating

the rule of the Court of Appeals for the Seventh Circuit that

> "retired Judge Major, of this circuit, is not qualified to vote on respondents' petition for rehearing *en banc* or to sit as a part of the court on said *en banc* hearing, if it is allowed."

And see Judge Schnackenberg's further opinion therein at pages 305-7. We also invite attention to the dissenting opinion of Circuit Judges Holmes and McCord in *United States v. Sentinel Fire Ins. Co.* (C.A. 5, 1949) 178 F.2d 217 at page 239.

(c) The issue in this case of whether two judges who are not active circuit judges qualified to sit *en banc* [28 U.S.C. § 46(c)] may block *en banc* proceedings *in limine* is closely related to the issue in *United States v. American-Foreign Steamship Corp.*, No. 138, October Term, 1959. Both are of substantial public importance and should be settled by this Court.

II. Respondent's Brief ignores the criteria of patentable invention which the Court of Appeals should apply.

The majority of the Court of Appeals felt themselves bound by fact findings of the district judge which reduced themselves to mere statements of commercial success. Respondent does not dispute the salient facts set forth in the petition (pp. 7-11, 15-16). On the contrary respondent's brief seemingly seeks to avoid the rule of this Court in *Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.* (1950) 340 U.S. 147 by stating that Molitor achieved the *first* commercial success (Respt's. Br. 12). No such distinction is justified by *A. & P.*

III. The question of whether a foreign reference cited against a patent as prior art must be construed more strictly than a domestic reference is in doubt and the subject of conflicting views by different Courts of Appeals. It should be resolved by this Court.

Respondent's brief garbles the decision in *Hollywood-Maxwell Co. v. Street's of Tulsa,* (C.A. 10, 1950) 183 F.2d 261. The court there specifically relied upon a French patent as a reference to invalidate the patent in suit despite the fact that "the French patent does not teach the patentable art * * * without further experimentation" (p. 263). The Court of Appeals for the Tenth Circuit required only that the experimentation be within the skill of an ordinary worker in the art. Respondent supports the view of the lower courts herein (Pet. 11, 16) that a foreign reference is to be more strictly construed than a domestic reference (Respt.'s Br. 13-14). No such distinction is made in the new patent act, 35 U.S.C. §§ 102-103 (Pet. 16-17), and the view squarely conflicts with that in the Tenth Circuit. The matter should be resolved by this Court.

IV. Respondent seeks to obviate the error of the Court of Appeals in denying due process by giving unwarranted stature to a trade journal on which the Court of Appeals relied.

Petitioners have been unable to locate any publication known as "Modern Plastics Encyclopedia (1959)" (Pet. 11-12). They have found an issue of a trade journal to which they believe the lower court referred. It contains voluminous advertising and offers of trade literature, advertising pamphlets, and the like. The title page bears the legend:

"MODERN PLASTICS"
"Encyclopedia Issue For 1959"
"September 1958"

The subscription rate to the magazine is listed on the same page and is stated to include the so-called "encyclopedia issue". Respondent's assertion that the "encyclopedia issue" is a reference work "published independently of the magazine" (Respt.'s Br. 6, 14) is palpably erroneous.

Respondent cites *Werk v. Parker* (1919) 249 U.S. 130. There the lower court correctly relied upon the British Encyclopedia, the Standard Dictionary of 1894, and other references for the purpose of showing that the purported invention of a later filed patent application was in fact old. Cf. 35 U.S.C. § 103 (a) and (b). The case is clearly inapposite here.

Respondent seeks to minimize the error of the Court of Appeals by reconstructing its language (Respt.'s Br. 14-15). Respondent urges that the word "this" refers not to the preceding sentence as an antecedent but to a concept of "replacement of the rubber latex process by the Molitor plastisol process" (Respt.'s Br. 15), a concept which is purportedly embodied in a number of the previous sentences of the opinion stating Molitor's commercial sucess. Reduced to simplest terms respondent urges that "this" (i.e. naked commercial success) "is one of the strongest indicia of invention". This is plainly contrary to the rule of this Court in *A. & P.* (Pet. 15-16).

Respectfully submitted

WALTER J. BLENKO
Attorney for Petitioners